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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/642,560 05/03/96 OKAMOTO

T REM-1

EXAMINER

F3M1/0226

ART UNIT 0111 PAPER NUMBER

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DATE MAILED: 3304

02/26/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 5/3/96 Application

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 21-40 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 21-40 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892 no new art

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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The Applicant has claimed priority under 35 U.S.C. 119(a)-(d). However, the certified copy of 5-108303 has not been submitted to the instant application. If the certified copy was submitted to parent application S/N 08/232,862, then the Applicant needs to inform the Office, so that the parent may be check for verification. Otherwise, the Applicant needs to
5 file a certified copy to the instant application.

The specification is objected to under 35 U.S.C. 112, first paragraph, as lacking in providing an adequate written description and enabling disclosure for the claimed invention. The specification fails to provide an adequate written description because it describes an embodiment without giving a description of what parts of the device perform the claimed
10 functions. The specification is non-enabled because it does not provide how to perform the functions claimed with the embodiment.

Claims 21-40 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth above. The Applicant may overcome this rejection by stating on the record what parts within the disclosure perform the claimed means-plus-functions in the claims.

15 Claims 21, 24-29, 32-38 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Because the Applicant uses means-plus-function language through the entire claim body, it is inferred that the Applicant is interested in protecting the function/process rather than the form. For receiving protection of a process,
20 the inventor needs to recite a method claim. Here the Applicant has recited an apparatus claim within the preamble. Therefore, there is an inconsistency between the preamble and the

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claim body which renders the claim indefinite. To correct the indefiniteness, Applicant should insert the subject matter of claims 22, 23, 30, 31 or 39 into each independent claim: 21, 29 and 36.

5 The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 29
10 USPQ2d 2010 (Fed. Cir. 1993).

 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

15 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

 Claims 21-40 are rejected under the judicially created doctrine of double patenting over claims 1-20 of copending Application No. 08/555,400.

20 The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: means for receiving data; means for effecting processing by using the data received; means for keeping time; means for interfering with the means for
25 effecting.

 Furthermore, there is no apparent reason why Applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also M.P.E.P. § 804.

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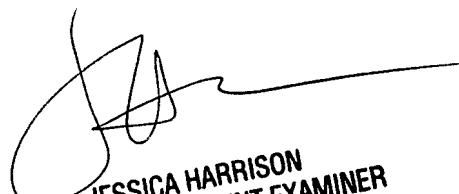
Any inquiry concerning the specifics of this communication should be directed to **Examiner Michael O'Neill**. Inquiries of a general nature should be directed to the Group 3300 receptionist. Official responses can be filed 24 hours a day to the Official fax number listed below, subject to the provisions of 37 C.F.R. 1.6(d). Unofficial faxes which are intended to be seen by the Examiner should be sent to the Unofficial Fax number below; it is strongly suggested that the Examiner be contacted directly at the time of sending any Unofficial Fax.

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